

## REMARKS

Applicant intends this response to be a complete response to the Examiner's **3 June 2011** Election/Restriction Requirement. Applicant has labeled the paragraphs in his response to correspond to the paragraph labeling in the Office Action for the convenience of the Examiner.

## DETAILED ACTION

### *Election/Restrictions*

The Examiner states and/or contends as follows:

Restriction is required under 35 U.S.c. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 and 31-39 drawn to a composition comprising a nano-particle core and a nano-structure.

Group II, claim(s) 11-12 and 47, drawn to a nano-structure composition comprising a nano-particle core and nano-rods.

Group III, claim(s) 40-46, drawn to a nano-structure composition comprising a nanoparticle core, a nano-structure, and a biocompatible polymer coating.

Group IV, claim(s) 48 a method for treating cancers or disease.

The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

None of the claimed inventions invention contains a special technical feature. Each of the claimed inventions comprise at least a nano-particle core. However, this feature is not considered a special technical feature because it does not make a contribution over the prior art when each invention is considered as a whole. For instance, Carpenter et al. (U.S. Patent No. 7,235,228) discloses nanoparticles having core/shell architecture. See Abstract.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee

required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicants traverse the election/restriction requirement on the grounds and all four groups require common elements, a core and a nano-structure. The structures may be different, but all comprise at least one conductive material. Group I claims relate to a general case, while Group II and Group III claims relate to specific structures or to compositions including a new layer – a layer of a biocompatible polymer. Group IV relates to a method for using the structures of Groups I-III. As all of these groups share at least two elements in common and all related to core with nano-structures with or without biocompatible polymer coatings, all should be examined collectively.

If the Examiner rejects the withdrawal of the entire rejection, Applicant requests withdrawal of the restriction with respect to group I-III as they all relate to compositions having cores and conductive nano-structures on the core, with or without biocompatible polymer coatings.

If the Examiner will not allow Groups I-III to be examined together, then Applicants request modification of the restriction to combine Groups I and III as Group III merely adds a biocompatible polymer coating.

Finally, if the Examiner maintains the full restriction requirement, then Applicants elect Group I, claims 1 and 31-39. Applicants expressly reserve the right to file divisional and/or continuation applications covering non-elected inventions and other inventions disclosed in the specification and not articulated in pending claims.

If it would be of assistance in resolving any issues in this application, the Examiner is kindly

invited to contact applicant's attorney Robert W. Strozier at 713.977.7000

**The Commissioner is authorized to charge or credit Deposit Account 501518 for any additional fees or overpayments.**

Date: **3 June 2011**

Respectfully submitted,

**/Robert W. Strozier/**

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